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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,126

07/10/2006

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EXAMINER

PALENIK, JEFFREY T

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/521,126</p>	<p><b>Applicant(s)</b> HISSINK, CATHARINA EVERDINA</p>	
	<p><b>Examiner</b> Jeffrey T. Palenik</p>	<p><b>Art Unit</b> 1615</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 26 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1,3-17,27 and 31-37.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments with regard to the rejection of claims 1, 3-17 and 27 under 35 USC 103(a) as being unpatentable over the combined teachings of Penco et al. and Cohn et al. have been fully considered but they are not persuasive. Applicant's Declaration submitted under 37 CFR 1.132 has also been considered and is not entered.

Applicants allege that Penco does not teach or suggest a separate PEG chain extender. In response to Applicant's argument that the reference fails to show certain features of Applicant's invention, it is noted that the features upon which applicant relies, (e.g. PEG is not taught as a separate chain-extender) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the Penco reference, Applicants further allege that there is no teaching or suggestion of different PLGA oligomers in the same multiblock copolymer.

In response, the Examiner respectfully disagrees and maintains that Penco does expressly teach and suggest that not only can the PLGA portion differ within the multiblock copolymer, but the PCDT block can as well. Page 1744 (left col., 1) discusses that the PLGA-PCDT copolymer compositions have two possible sources of non-uniformity; the first of which is internal to the PLGA block itself. The second source may arise from the PLGA-PCDT block distribution. Penco further suggests that anomalous non-uniform distribution of the different blocks has been shown to occur based on the acquisition of different light-scattering patterns. Regarding the "internal" source of variation within the PLGA block, the teachings of Penco suggest that this is related to PLGA blocks of different weight, as evidenced by Figure 1 on page 1743, and the discussion thereto which discusses, for example, PLGA 75/25 as having an average molecular weight of 93.2 (103) g/mol. The forgoing discussion would minimally suggest that in addition to Penco teaching different PLGA oligomers, that the copolymers also can have different lengths of both PLGA and PCDT within the same copolymer.

Regarding Applicant's remarks directed toward how the copolymer is produced, the Examiner respectfully maintains that the instant claims are directed to a biodegradable copolymer composition, rather than the production of such a compound.

Applicant further alleges, in both the response and the Declaration, that the Cohn reference discusses the preparation of alternating block copolymers of uniform length. Paragraphs 14 and 16 of the Declaration touch on Applicant's point that "ACA" triblock copolymers are uniform in length, suggesting that even a triblock structured as A1CA2CA1CA3 ... etc., neither teaches nor suggests random distribution of the blocks throughout the copolymer.

In response, the Examiner respectfully disagrees and maintains that Cohn does expressly teach in [0012] that the "A" blocks of both the "AB" and "ACA" block copolymers is a polyester unit which is prepared by polymerizing the instantly claimed cyclic and non-cyclic monomers. This expressly suggests that "A" blocks of different lengths and distribution may be prepared by the ordinarily skilled artisan. That said the "A" block may be randomly comprised of repeated lactic acids, glycolic acids or a mixture of both. Similarly, this teaches and suggests that the same block may also be composed of one or more caprolactone molecules.

For these reasons, Applicants' arguments are found unpersuasive. Said rejection is therefore maintained.

/Jeffrey T. Palenik/  
Examiner, Art Unit 1615

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615

